



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,945	06/21/2001	Phillip S. Wilson	P281188	6284

909 7590 09/25/2003

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

SALVATORE, LYNDIA

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary

Application No.

09/868,945

Applicant(s)

WILSON, PHILLIP S.

Examiner

Lynda M Salvatore

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-946) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment and accompanying remarks have been carefully considered and entered. Claims 1,3,4, and 5 have been amended as requested. Presently, claims 1-10 remain pending. Applicant's amendments are found sufficient to overcome the 35 U.S.C. 112, second paragraph rejections set forth in sections 8-10 of the last Office Action. As such these rejections are withdrawn. Despite this advance, however, Applicant's amendments are not found to patentably distinguish the claims from the prior art of record and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Election/Restrictions

2. Applicant's election without traverse of claims 1-5 is acknowledged.
Claims 6-10 have been withdrawn from consideration as non-elected.

Claim Rejections - 35 USC § 112

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the recitation of "less than 100% of said reinforcing particles being less than 10 layers thick" is not sufficiently supported by the disclosure stating that exfoliation (delamination and dispersion) of layered mineral particles into constituent layers need not be complete in order to achieve the objects of the present invention, since incomplete exfoliation also results in particles less than 10 microns in thickness.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al., US 4,739,007 in view of Christiani et al., US 5,747,560 as set forth in section 13 of the last Office Action.

Applicant amended claim 1 to further include the limitation of "less than 100% of said reinforcing particles being less than 10 layers thick" and argues that the relied upon patent to Christiani et al, teaches that all (i.e., 100% of the platelet particles) must be less than about 10 layers thick (Applicant's response, page 8). This argument is not found persuasive on the grounds that it is the position of the Examiner that the teaching to about less than 10 layers would encompass values less than 10 layers and values greater than 10 layers. Thus, it is the position of the Examiner that the combination of Okada et al., in view Christiani et al., teaches all of the limitations present in amended claim 1.

With respect to the argument that the Christiani et al., teaches .5-150 parts by weight instead of 2% to about 15% by volume (Applicant's response, page 9), it is the position of the Examiner that the weight percentages taught by Christiani et al., would be equal to the claimed volume ranges. The Examiner agrees that the disclosure is not the same because Christiani et al., teaches weight percentages whereas the instant invention claims the amount of silicate layers dispersed in the polymer matrix in terms of volume, however, it is the position of the Examiner that since the Christiani et al., teaches the same utility as the instantly claimed invention it is

Art Unit: 1771

reasonable to presume that the same volume of platelets are employed. The burden is shifted to the Applicant to evidence that parts by weight range taught by Christiani et al., is not equal to the volume range of the instantly claimed invention.

Applicant also argues that the Examiner's assertion that embossing would produce the claimed protrusions is incorrect. Applicant contends that reinforcement fibers such as glass fibers, inhibit substantial flow of molten material and as a result the fibers do not align with the longitudinal direction of the protrusions, and an insufficient amount of glass fibers will enter into protrusions of thicknesses of 1/10" or less (Applicant's response, page 10). This argument is not found persuasive on the grounds that Applicant's claim 1 does not preclude glass fibers. The Examiner assumes that Applicant is arguing that using the glass fibrous structures to form the reinforced molded article is not suitable, however, Applicant fails to set forth this limitation in any of the claims. Moreover, the Christiani et al., teaches that the composite material is suitable as a coating on a variety of substrates including plastics. Thus, without such limitations directed to the decorative material it is the position of the Examiner that embossing would produce the recited protrusions in claim 1. The burden is shifted to the Applicant to evidence the contrary.

6. Claims 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al., US 4,739,007 in view of Christiani et al., US 5,747,560 as applied to claim 1, and further in view of Simm et al., US 4,447,488 as set forth in section 14 of the last Office Action and no new arguments have been presented.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

September 12th, 2003
ls


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700